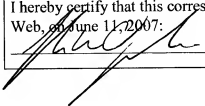


CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted to the USPTO through EFS-Web, on June 11, 2007:



PATENT APPLICATION
Docket No.: 3003.2.10B

UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Sanchaita Datta and Ragula Bhaskar
Application No.: 10/034,190
Filed: December 28, 2001
For: Domain name resolution making IP address selections in response to connection status when multiple connections are present
Art Unit: 2155
Examiner: Philip B. Tran

APPELLANTS' REPLY

(Regarding an Application which has been *Made Special*)

Honorable Commissioner for Patents:

In response to the Examiner's Answer mailed June 5, 2007, and pursuant to 37 C.F.R. §§ 41.30 *et seq.*, Applicants respectfully submit the following.

Section 112: Written Description

At pages 17-19, the Answer asserts a lack of support under Section 112 for negative claim limitations. But the Answer misconstrues the cited authorities. Properly understood, the authorities support the adequacy of this application's written description. Per M.P.E.P. § 2173(i) and In re Johnson, for instance, "If

alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” Proximity to the server is positively recited in the present specification on page 10. That recitation is clearly done in the alternative, as shown by Applicants’ use of the terms “such as”, “may”, and perhaps most tellingly, “and/or” in the recitation. Under the authorities cited by the Answer, this positive recitation of alternative elements is sufficient to satisfy Section 112.

The Answer also cites Ex parte Grasselli as authority, but Grasselli is limited to a situation where the factual evidence of record supports a conclusion that negative limitations therein introduce new concepts into the application disclosure as originally filed. See Ex parte Parks, BPAI Appeal No. 93-2740 (unpublished); Ex parte Lana, BPAI Appeal No. 1998-3189 (unpublished). The concept of proximity to the server was not newly introduced by these claims. Rather, server proximity is discussed in the present application at page 2 line 18 through page 3 line 3, and again at page 10 lines 14-21.

Accordingly, these Section 112 rejections should be reversed. The application as originally filed provides a written description that supports the negative claim limitations.

Section 112: Enablement

At pages 19-21, the Answer asserts a lack of enablement under Section 112 for negative claim limitations. But the Answer fails to rebut the argument made at page 11 of the January 18, 2007 Appeal Brief, which points out that – as a matter of law – enablement cannot be analyzed without addressing the level of ordinary skill in the art. The Examiner has provided no evidence or reasoning to support a

determination of the level of ordinary skill in the art with respect to the negative limitations in question. Therefore, the enablement rejections should be reversed.

However, the application need not be remanded. This application was granted accelerated examination status more than 4 years ago (on June 2, 2003). Remanding it to the Examiner now for a determination of the level of ordinary skill will further delay issuance of the claims to which Applicants are entitled.

The undersigned respectfully submits that with respect to the negative limitations, the level of ordinary skill need only be sufficient to recognize whether IP address selection is made with regard to proximity to the server. One of skill would understand, for example, that hop count and geographic location are factors based on proximity to the server, and that availability and link load, for example, are factors not based on proximity to the server. One of skill could determine experimentally – by comparing IP address selections made for servers at different geographic locations – whether a given implementation responds in a statistically significant way to proximity of the server. Given the necessary equipment and network access, one of skill could perform such an experiment and analyze the results in a matter of hours, or at most a few days. Alternately, one of skill could review the source code and/or schematics of an implementation to determine what factors are considered during IP address selection. The Board may also note that references must be enabling to be properly cited, so the details about server proximity usage disclosed in prior art would be known to one of skill to support experiments and/or code analysis to detect reliance on server proximity during IP address selection, and to implement reliance on other factors. In view of all this, the undersigned respectfully submits that undue experimentation would not be

needed for one of ordinary skill to implement an embodiment that performs IP address selection without regard to server proximity.

Section 103 References: Improper Combination

The Answer adds no evidence to support the combination of Zisapel and Bommareddy on which the rejections rely. The Answer cites several opinions, primarily from the CCPA. These opinions provide background, but they do not and cannot change the recent holding of the United States Supreme Court in KSR Int'l Co. v. Teleflex Inc., 550 U.S. ____ (2007). As the KSR Court states, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” KSR, slip op. at 14. As the Appeal Brief notes on pages 13-16, Zisapel and the present invention are directed to domain name resolution, which has conventionally been focused on servers. Bommareddy focuses instead on router clustering and says nothing substantial about domain name resolution. Common sense – which is praised in KSR – suggests that one of skill in the art who was looking for ways to improve domain name resolution would therefore have searched for ways to improve server efficiency, not for ways to cluster routers.

KSR also discusses obviousness tests for situations in which known devices are combined according to their known functions. The present invention is not such a combination. Zisapel teaches IP address selection for the function of domain name resolution and Bommareddy teaches router pinging for the function of clustering routers. The present invention, by contrast, is directed e.g. toward router pinging for the function of domain name resolution.

It would not have been obvious at the time of invention for one of skill in the art to combine Zisapel and Bommareddy. The Section 103 rejections based on combining those references should be reversed.

Section 103: Teaching Away

The Appeal Brief at pages 16-17 explains that Zisapel teaches away from the present invention's approach of selecting IP addresses without regard to server proximity. In support, the Appeal Brief cites to some sections of Zisapel which were annotated by the Examiner.

In an attempt to rebut this teaching away, the Examiner's Answer asserts on page 23 that Zisapel teaches "IP address selection made without regard to the router's proximity to the server (i.e., selecting IP address based upon F content function) [see Col. 17, Line 35 to Col. 18, Line 59]."

But in fact the F content function that is cited by the Answer *does* consider proximity to the server. Within the very section cited by the Answer, Zisapel column 18 lines 1-2 state that the Decision Parameter Table for the decision function "is preferably dependent on" parameters that include a "Hops weighting factor". Hops measure server proximity. Moreover, the definition of function F_{content} given in column 18 lines 29-32 lists "Hops weighting" and "Hops count" as factors.

Even if Zisapel were combined with Bommareddy, one of skill in the art would have been led away from the present invention, not toward it, by the combination. The rejections based on Zisapel should be reversed.

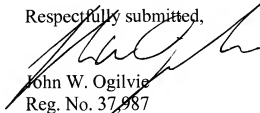
Conclusion

For at least the reasons given above and in the Appeal Brief, Appellants respectfully request reversal of the rejections and prompt allowance of all claims.

Dated June 11, 2007.

\pReply-10B

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John W. Ogilvie", is written over the typed name and the first two lines of the address.

John W. Ogilvie

Reg. No. 37,987

OGILVIE LAW FIRM

1320 East Laird Avenue

Salt Lake City, UT 84105

801-706-2546 (voice)

801-583-0393 (fax)